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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,425	12/20/2001	Tetsuya Kawai	217361US0	3808

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EXAMINER

ELHILO, EISA B

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/022,425

Applicant(s)

KAWAI ET AL.

Examiner

Eisa B Elhilo

Art Unit

1751

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 1 and 2 are pending in this application.

## DETAILED ACTION

### *Claim Objections*

1. Claim 2 objected to because of the following informalities:

The word "bond" in line 20 is misspelled. Appropriate correction is required.

- 2 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. (US 6,071,504).

Kawai (US' 504) teaches a hair dyeing composition comprising direct dyes (see col. 5, line 45), hydrocarbon oils (see col. 6, lines 8-14), alkoxy-modified silicone of dimethyl polysiloxane and polyether-modified silicone of a formula (I) (see col. 2, lines 40-65 and formula I) and organic solvent of aromatic alcohols of the formula (A), which is similar to the claimed formula (1), when in the reference's formula (A), X is alkyleneoxy group having 2 to 4 carbon atoms and I is zero and the oxygen atom of the alkyleneoxy group is bonded to the benzene ring to form a phenoxyethanol alcohol (ph-OCH<sub>2</sub>CH<sub>2</sub>CH<sub>2</sub>-OH) as claimed in claim 2 (see col. 4, lines 5-28) and when in the claimed formula (1), R<sub>1</sub> represents the benzene ring of the claimed formula in which R<sub>2</sub> is a hydrogen atom and R<sub>3</sub> is a single bond, p = zero, q = 1, Z is a hydrogen atom and Y is a hydroxyl group as claimed.

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The claims differ from the reference by reciting a hair dyeing composition comprising a specific combination of dyeing ingredients such as a direct dye, a hydrocarbon oil and polyoxyalkylene-modified dimethyl polysiloxane.

However, the reference teaches a hair dyeing composition that comprises all the dyeing ingredients as claimed.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition by combining all these dyeing ingredients in a single hair dyeing composition with a reasonable expectation of success because the reference teaches a hair dyeing composition comprising dyeing ingredients such as modified silicone (see col. 2, lines 40-65), organic solvents such as an aromatic alcohol for dyeing effects (see col. 4, lines 5-43), a direct dye for change the color shade of the hair (see col. 5, lines 43-46) and optional ingredients such as hydrocarbon oil (liquid paraffin) for viscosity and gel-strength adjustors (see col. 6, lines 4-12), and, thus a person of the ordinary skill in the art would expect such a composition to have similar properties to those claimed, absent unexpected results.

### ***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (US 5,332,581), (6,240,929 B1) and (US 6,197,911 B1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Eisa Elhilo  
Patent Examiner  
Art Unit 1751

August 13, 2003